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EXAMINER

CHOUDHURY, AZIZUL Q

ART UNIT

PAPER NUMBER

2145

DATE MAILED: 01/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/785,240

Applicant(s)

HART, MATTHEW THOMAS

Examiner

Azizul Choudhury

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-11, 21-23, 33-35 and 37-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-11, 21-23, 33-35 and 37-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

This office action is in response to the correspondence received on October 12, 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-11, 21-23, 33-35 and 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pollack et al (US Pat No: 6,546,390) in view of Dieterman (US Pat No: 6,393,464), hereafter referred to as Pollack and Dieterman, respectively.

1. With respect to claims 9, 21 and 33, Pollack teaches through Dieterman, a computer program product comprising a computer program operable to control a computer to process received e-mail messages, said computer program comprising: (i) e-mail filtering logic operable to receive an e-mail message and to apply at least one test to identify a received e-mail message as a potentially unwanted e-mail message; and (ii) message forwarding logic operable to forward said potentially unwanted e-mail message to its addressee together with a prompt for said addressee to provide feedback as to whether or not said received e-mail message is an unwanted e-mail message (column 6, line 45 – column 7, line 3, Pollack); wherein a rule associated with said e-mail filtering logic is added

if a threshold of a predetermined number of votes positively identifies said potentially unwanted e-mail message as an unwanted e-mail message (column 3, lines 51-60, Pollack); wherein said e-mail filtering logic uses a scoring algorithm responsive to identification of predetermined words within said received e-mail message and a message size of said received e-mail message to identify said received e-mail message as a potentially unwanted e-mail message (text search means found within column 8, lines 10-25 and column 5, lines 1-5, Pollack) (file size means are found within column 6, lines 19-23, Pollack).

(Pollack discloses the response from the user but does not specifically disclose the prompt that is sent to the user with the potentially unwanted (spam) email. However, Dieterman, in the same field of endeavor, discloses prompting an administrator for approval of a potentially unwanted e-mail message (Dieterman, column 5, lines 24-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an approval prompt, disclosed by Dieterman, into the email filtering system disclosed by Pollack, in order for parents to filter unwanted e-mail messages (column 1, lines 41-50, Dieterman)).

2. With regards to claims 10, 22 and 34, Pollack teaches through Dieterman, a computer program product wherein said potentially unwanted e-mail message is forwarded encapsulated within a markup language document including a hypertext markup language document capable of being displayed utilizing a

network browser, the document providing voting buttons to allow said addressee to provide said feedback (Pollack provides means for the emails to be retrieved through a web interface (column 6, lines 30-32, Pollack). Pollack's design also allows for a voting interface (column 9, line 60 – column 10, line 19, Pollack).

Pollack discloses the response from the user but does not specifically disclose the prompt that is sent to the user with the potentially unwanted (spam) email. However, Dieterman, in the same field of endeavor, discloses prompting an administrator for approval of a potentially unwanted e-mail message (Dieterman, column 5, lines 24-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an approval prompt, disclosed by Dieterman, into the email filtering system disclosed by Pollack, in order for parents to filter unwanted e-mail messages (column 1, lines 41-50, Dieterman)).

3. With regards to claims 11, 23 and 35, Pollack teaches through Dieterman, a computer program product wherein said message filtering logic is operable to add a new test to those applied to said received e-mail messages in dependence upon said feedback (Pollack teaches a design allowing users to add/delete preferences (rules) dynamically or interactively (manually) (column 7, lines 48-64, Pollack).

Pollack discloses the response from the user but does not specifically disclose the prompt that is sent to the user with the potentially unwanted (spam)

email. However, Dieterman, in the same field of endeavor, discloses prompting an administrator for approval of a potentially unwanted e-mail message (Dieterman, column 5, lines 24-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an approval prompt, disclosed by Dieterman, into the email filtering system disclosed by Pollack, in order for parents to filter unwanted e-mail messages (column 1, lines 41-50, Dieterman)).

4. With regards to claim 37, Pollack teaches through Dieterman, a computer program product wherein said scoring algorithm is responsive to an addressee list of said received e-mail message (Pollack teaches a design allows filtering by many means including author (column 6, lines 19-23, Pollack).

Pollack discloses the response from the user but does not specifically disclose the prompt that is sent to the user with the potentially unwanted (spam) email. However, Dieterman, in the same field of endeavor, discloses prompting an administrator for approval of a potentially unwanted e-mail message (Dieterman, column 5, lines 24-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an approval prompt, disclosed by Dieterman, into the email filtering system disclosed by Pollack, in order for parents to filter unwanted e-mail messages (column 1, lines 41-50, Dieterman)).

5. With regards to claim 38, Pollack teaches through Dieterman, a computer program product, further comprising test-creating logic operable to allow creation of a new test to be added to said at least one test provided by said e-mail filtering logic (Pollack teaches a design allowing users to add/delete preferences (rules) dynamically or interactively (manually) (column 7, lines 48-64, Pollack).

Pollack discloses the response from the user but does not specifically disclose the prompt that is sent to the user with the potentially unwanted (spam) email. However, Dieterman, in the same field of endeavor, discloses prompting an administrator for approval of a potentially unwanted e-mail message (Dieterman, column 5, lines 24-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an approval prompt, disclosed by Dieterman, into the email filtering system disclosed by Pollack, in order for parents to filter unwanted e-mail messages (column 1, lines 41-50, Dieterman)).

6. With regards to claim 39, Pollack teaches through Dieterman, a computer program product wherein said computer program is arranged to receive and process e-mail messages before said e-mail messages reach an associated target e-mail server (Figure 1 of Pollack's design illustrates that such means are present.

Pollack discloses the response from the user but does not specifically disclose the prompt that is sent to the user with the potentially unwanted (spam)

email. However, Dieterman, in the same field of endeavor, discloses prompting an administrator for approval of a potentially unwanted e-mail message (Dieterman, column 5, lines 24-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an approval prompt, disclosed by Dieterman, into the email filtering system disclosed by Pollack, in order for parents to filter unwanted e-mail messages (column 1, lines 41-50, Dieterman)).

7. With regards to claim 40, Pollack teaches through Dieterman, a computer program product, wherein said prompt for said addressee to provide feedback is not forwarded with said potentially unwanted e-mail if an administrator identifies said e-mail message as being wanted (Pollack discloses the response from the user but does not specifically disclose the prompt that is sent to the user with the potentially unwanted (spam) email. However, Dieterman, in the same field of endeavor, discloses prompting an administrator for approval of a potentially unwanted e-mail message (Dieterman, column 5, lines 24-46). It is also described how a message prompt does not always have to be sent. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an approval prompt, disclosed by Dieterman, into the email filtering system disclosed by Pollack, in order for parents to filter unwanted e-mail messages (column 1, lines 41-50, Dieterman)).

8. With regards to claim 41, Pollack teaches through Dieterman, a computer program product wherein said rule associated with said e-mail filtering logic is confirmed manually (Pollack teaches a design allowing users to add/delete preferences (rules) dynamically or interactively (manually) (column 7, lines 48-64, Pollack)).

Pollack discloses the response from the user but does not specifically disclose the prompt that is sent to the user with the potentially unwanted (spam) email. However, Dieterman, in the same field of endeavor, discloses prompting an administrator for approval of a potentially unwanted e-mail message (Dieterman, column 5, lines 24-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an approval prompt, disclosed by Dieterman, into the email filtering system disclosed by Pollack, in order for parents to filter unwanted e-mail messages (column 1, lines 41-50, Dieterman)).

9. With regards to claim 42, Pollack teaches through Dieterman, a computer program product, wherein said manual confirmation is not required if a predefined number of highly trusted users positively identify said potentially unwanted e-mail message as an unwanted e-mail message (Pollack teaches a design with means for filtering based on the consensus of user feedbacks (column 3, line 61 – column 4, line 18 and column 6, line 45 – column 7, line 3, Pollack)).

Pollack discloses the response from the user but does not specifically disclose the prompt that is sent to the user with the potentially unwanted (spam) email. However, Dieterman, in the same field of endeavor, discloses prompting an administrator for approval of a potentially unwanted e-mail message (Dieterman, column 5, lines 24-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an approval prompt, disclosed by Dieterman, into the email filtering system disclosed by Pollack, in order for parents to filter unwanted e-mail messages (column 1, lines 41-50, Dieterman)).

10. With regards to claim 43, Pollack teaches through Dieterman, a computer program product wherein said prompt for said addressee to provide feedback is not forwarded with said potentially unwanted e-mail and said rule is not added if said rule is not confirmed manually (Pollack teaches a design allowing users to add/delete preferences (rules) dynamically or interactively (manually) (column 7, lines 48-64, Pollack).

Pollack discloses the response from the user but does not specifically disclose the prompt that is sent to the user with the potentially unwanted (spam) email. However, Dieterman, in the same field of endeavor, discloses prompting an administrator for approval of a potentially unwanted e-mail message (Dieterman, column 5, lines 24-46). It is also described how a message prompt does not always have to be sent. It would have been obvious to one having

ordinary skill in the art at the time the invention was made to incorporate an approval prompt, disclosed by Dieterman, into the email filtering system disclosed by Pollack, in order for parents to filter unwanted e-mail messages (column 1, lines 41-50, Dieterman)).

Response to Remarks

The amendment received on October 12, 2005 has been carefully examined but is not deemed fully persuasive. In view of the submission of the terminal disclaimer, the double patenting rejection has been retracted. However, in view of the amended claim language and the additional new claims, a new search was performed and more pertinent art has been discovered and applied.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Azizul Choudhury whose telephone number is (571) 272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AC


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SUPERVISORY PATENT EXAMINER